



**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. : 10/664,039  
Applicant : STOCKSTILL, JOHN W.  
Filed : SEPTEMBER 17, 2003  
Title : COMBINATION INTERPROXIMAL DENTAL STRIPPER

Art Unit : 3732  
Examiner : WILSON, JOHN J.

Atty Docket No. : MCOG-0002-UT1

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

In conjunction with the Notice of Appeal concurrently filed for the above application involving Claims 1 and 4-17 on appeal, Applicant respectfully requests a Pre-Appeal Brief Review further to the Official Gazette Notice of July 12, 2005 and the January 10, 2006 Extension thereof which authorizes Pre-Appeal Brief Conferences.

**I. Basis for Request for Review.**

This request is necessitated by: (1) the failure of the Examiner to comply with 37 CFR § 1.104(d)(2) in providing the Affidavit/Declaration requested in Applicant's June 5, 2006 Amendment (Applicant's June Amendment); (2) the failure of the Examiner to comply with 37 CFR § 1.104(d)(2) in providing the Affidavit/Declaration requested in Applicant's September 18, 2006 Amendment After Final (Applicant's Amendment After Final); and (3) the failure of the Final Office Action and October 4, 2006 Advisory Action (Advisory Action) to comply with MPEP § 706.02(j) in providing a proper "motivation to combine" the references relied on in rejecting Claims 1 and 4-17.

**A. Failure to Comply with 37 CFR § 1.104(d)(2) in Providing Affidavit/Declaration in Response to Request in Applicant's June Amendment.**

In the March 15, 2006 Non-Final Office Action (Non-Final Office Action), the Examiner rejected Claims 4-16 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,836,810 to Asum (Asum) in view of U.S. Patent No. 6,386,873 to Blank (Blank) and further in view of U.S. Patent No. 4,690,642 to Kyotani (Kyotani), despite failing to provide proper motivation for combining the cited references.

In responding to the Non-Final Office Action, (see Applicant's June Amendment, pp. 9-10), Applicant properly requested the Examiner to supply an Affidavit/Declaration under 37 CFR § 1.104(d)(2) to provide the factual evidence upon which the Examiner relied in finding motivation to combine with Blank with Asum and the evidence upon which the Examiner relied upon in finding motivation to combine Kyotani with the combination of Blank and Asum. However, to date, the Examiner has failed to provide the Applicant with the requested Affidavit/Declaration.

Applicant notes that in the unpublished case of *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), the PTO argued "the procedures established by 37 C.F.R. Section 1.107(b) (1993) [now 37 CFR § 1.104(d)(2)] *expressly entitle* an applicant, on mere request, to an examiner affidavit that provides [citations that support the Examiner's asserted level of skill in the art]" (emphasis added). Furthermore, in *In re Sun*, the Federal Circuit, held that "this procedure, so readily available, helps save the lack of citation in an office action from possible constitutional infirmity in denying reasonable notice and hence due process." See 31 USPQ2d at 1455. Accordingly, the Examiner's failure to comply with 37 CFR § 1.104(d)(2) has also denied the Applicant his statutory rights under the Administrative Procedures Act, as well as his Constitutional rights under the Fifth Amendment, to reasonable notice and due process.

Therefore, because the Examiner has failed to provide Applicant with the properly requested Affidavit/ Declaration, under 37 CFR § 1.104(d)(2), the rejection of Claims 4-16 over Asum in view of Blank and further in view of Kyotani is *prima facie* improper and should be withdrawn.

**B. Failure to Comply with 37 CFR § 1.104(d)(2) in Providing Affidavit/Declaration in Response to Request in Applicant's Amendment After Final.**

In the Final Office Action, the Examiner rejected Claims 1, 4-6, 8, 10-13, 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Asum in view of Blank, despite failing to provide proper motivation for combining Blank with Asum. In the Final Office Action, the Examiner also rejected Claims 7, 9, 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Asum in view of Blank and further in view of Kyotani, despite failing to provide proper motivation for combining Kyotani with the combination of Blank and Asum. Applicant properly requested the Examiner to provide the factual evidence upon which the Examiner relied in finding motivation to combine Blank with Asum and the evidence upon which the Examiner relied in finding motivation to combine Kyotani with the combination of Blank and Asum (see Applicant's Amendment After Final, Section G, p. 12). However, to date, the Examiner has failed to provide the Applicant with the requested Affidavit/Declaration. The Examiner's comments in the Advisory Action also fails to address Applicant's Request for an Affidavit/ Declaration, under 37 CFR § 1.104(d)(2) in Applicant's Amendment After Final.

Because the Examiner has failed to provide Applicant with the properly requested Affidavit/Declaration, under 37 CFR § 1.104(d)(2) in Applicant's Amendment After Final, the rejection of Claims 1 and 4-17 over the cited references and the combination of Asum in view of Blank or over that combination further in view of Kyotani is *prima facie* improper and should be withdrawn (See *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), quoted above).

**C. Failure to Articulate in both the Final Office Action and in the Advisory Action a Proper "Motivation to Combine" References.**

As set forth in Section 706.02(j) of the MPEP, "To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, *either in the references themselves or in the knowledge generally available to one of ordinary skill in the art*, to modify the reference or to combine reference teachings. . . *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.* *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added)."

Nowhere does Final Office Action: (a) provide a proper basis for combining the teachings of the references relied on in rejecting Claims 1 and 4-17; (b) articulate any proper "motivation to combine" these references; or (c) explain where the "motivation to combine" can be found in these references or elsewhere in the art:

1. In rejecting Claims 1, 4-6, 10-13, 15 and 17 over Asum in view of Blank, the Final Office Action fails to provide an appropriate basis for combining Blank with Asum for at least the reasons discussed in Section D Applicant's Amendment After Final (see pp. 5-8).
2. In rejecting Claims 7, 9, 14 and 16 over Asum in view of Blank and further in view of Kyotani, the Final Office Action fails to provide an appropriate basis for combining Kyotani with the combination of Blank and Asum for at least the reasons discussed in Section E Applicant's Amendment After Final (see pp. 8-11).

Furthermore, as discussed in Section G of Applicant's Amendment After Final, the Final Office Action at pages 3-4 makes a allegation regarding the issue of motivation, but fails provide textual support and any other evidence in support of the allegation. The Advisory Action makes a similar allegation (see Advisory Action, p. 2), and, once again, cites no portion of any reference in support of its allegation and provides no other evidence in support of its allegation.

As held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these

components for combination in the manner claimed.”). However, neither the Final Office Action nor the Advisory Action have provided evidence from the art showing that a skilled artisan, with no knowledge of the claimed invention, would have been motivated to combine the cited references to produce the claimed invention.

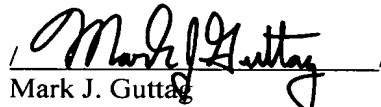
For at least the above reasons, the rejection of Claims 1, 4-6, 10-13, 15 and 17 over Asum in view of Blank and the rejection of Claims 7, 9, 14 and 16 over Asum in view of Blank and further in view of Kyotani set forth in the Final Office Action and affirmed by the Advisory Action fail to comply with MPEP § 706.02(j).

## **II. Relief Requested.**

For at least the reasons discussed above: (1) the Examiner has failed to comply with 37 CFR § 1.104(d)(2) in providing the Affidavit/Declaration requested in Applicant’s June Amendment; (2) the Examiner has failed to comply with 37 CFR § 1.104(d)(2) in providing the Affidavit/Declaration requested in Applicant’s Amendment After Final (Applicant’s Amendment After Final); and (3) the Examiner has failed to comply with MPEP § 706.02(j) in providing a proper “motivation to combine” the references relied upon in rejecting Claims 1 and 4-17. Accordingly, the rejections of Claims 1 and 4-17, are *prima facie* improper and should be withdrawn.

Therefore, Applicant hereby requests that all of the rejections be withdrawn and Claims 1 and 4-17 be allowed.

Respectfully submitted,

  
Mark J. Guttag  
Reg. No. 33,057

**JAGTIANI + GUTTAG**  
Democracy Square Business Center  
10363-A Democracy Lane  
Fairfax, Virginia 22030  
703-591-2664

November 30, 2006